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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/642,685	08/21/2000	Stephen Michael Matyas, Jr.	5577-202	8886

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EXAMINER

DADA, BEEMNET W

ART UNIT	PAPER NUMBER
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2135

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/642,685

Applicant(s)

MATYAS, JR. ET AL.

Examiner

Beemnet W Dada

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213..

Disposition of Claims

- 4) ☒ Claim(s) 2-16, 18-34 and 36-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-16, 18-34 and 36-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 2, 10, 14-15, 19,26, 34, 36, 39, 40, 41and 42 have been amended, claims 1, 17, 35 and 43 have been cancelled, in an amendment filed on July 2, 2004. Claims 2-16, 18-34 and 36-42 are pending.

Response to Arguments

2. Applicant's arguments with respect to claims 2-16, 18-34 and 36-42 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 2-16, 18-34 and 36-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chou et al US Patent 5,337,357 in view of Saito US Patent 6,408,390 B1.

5. As per claims 2, 15, 26, 34, 37, 39 and 40-42 Chou et al teaches controlling installation of software (abstract) comprising: an installation center (central processing center, col 3 In

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48-57), the installation center having access to first and second secret values associate with a copy of the software for installation (key k1 and k2, col 3 In 48-56) an unencrypted installation client, the installation client incorporating the first secret value (key k1, col 3 In 26-47); and an encrypted portion of the software, wherein the encrypted portion of the software is encrypted with a first key value (K) derived from the first and second secret values (k1 and k2, col 3 In 26-38 and 48-57, also col 4 In 5-12); and wherein the unencrypted installation client is configured to receive the second secret value from the installation center (processing center col 3 In 48-57) to generate the first key value, to decrypt the encrypted portion of the software and to install the software (col 4 In 4-11). Chou et al discloses determining if the installation of the copy of the software to be installed authorized (col 3 In 59-col 4 In 3), communication with the processing center and supplying the received information to the computer (col 3 In 48-67). Chou et al further discloses a need to provide protection in software program distribution (col 1 In 45-50).

Chou et al does not explicitly teach the installation client being configured to generate a second key value from the first key value and the first secret value, encrypt the decrypted portion of the software with the second key value and store the portion of the software encrypted with second key value.

However, within the same field of endeavor Saito teaches a system for installation of software, including transferring encrypting data to a customer, where data is encrypted using a first secret-key (key value Ks1) (col 13, lines 44-53) (note that key value Ks1 is generated at the transmitter and customer side on the basis of customer information IC, or bank information IBS and key generation data, see col. 24 lines 46-64). Saito further teaches the customer generating a second secret-key Ks2, using customer information IC and the first secret-key Ks1 (col 24, line 65—col 25, line 5), and decrypting the data using key value Ks1 and re-encrypting the

decrypted data using key value Ks2 (col. 14, lines 17-34). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to implement a method of generating a second key value from a first key value and a secret information, and re-encrypt a decrypted portion of content as taught by Saito into the system of Chou et al, in order to limit and control transfer and copying of data from a primary customer to secondary customers.

6. As per claims 3, the combination of Chou et al and Saito teaches the method as applied above. Furthermore, Saito teaches the installation server further configured to generate the first key value and store the first key value as a subsequent second secret value associated with the copy of the software [col 24, lines 41-59].

7. As per claim 4 and 19-22, the combination of Chou et al and Saito teaches the method as applied above. Furthermore, Saito teaches the installation server is further configured to retain a copy of an initial second secret value associated with the copy of the software and to selectively provide the initial second secret value to the installation client [col 24, lines 57-64].

8. As per claims 5-6, the combination of Chou et al and Saito teaches the method as applied above. Furthermore, Saito teaches limiting repetitions of copying or transferring of data [col. 6 lines 9-12].

9. As per claims 7-9, 16, 18 and 38, the combination of Chou et al and Saito teaches the method as applied above. Furthermore, Saito teaches decrypting the data using key value Ks1 and re-encrypting the decrypted data using key value Ks2 (col. 14, lines 17-34).

10. As per claim 10-11 and 23-24 the combination of Chou et al and Saito teaches the method as applied above. Furthermore, Chou et al teaches determining if the installation of the copy of the software to be installed authorized (col 3 ln 59-col 4 ln3).

11. As per claims 12 and 13, the combination of Chou et al and Saito teaches the method as applied above. Furthermore, Saito teaches the method further comprising a network interconnecting the installation server and the installation client [figure 6].

12. As per claims 14 and 27, the combination of Chou et al and Saito teaches the method as applied above. Furthermore, Saito teaches the system wherein the installation client is further configured to copy encrypted portion of the data from the read only storage device to a writeable storage device and to store the portion of the software encrypted with the second key value so as to overwrite the encrypted portion of the software on the writeable storage device [col. 14, lines 9-55].

13. As per claim 25, the combination of Chou et al and Saito teaches the method as applied above. Furthermore, Saito teaches limiting repetitions of copying or transferring of data [col. 6 lines 9-12].

14. As per claim 28-30, the combination of Chou et al and Saito teaches the method as applied above. Furthermore, Saito teaches the installation server is further configured to retain a copy of an initial second secret value associated with the copy of the software and to selectively provide the initial second secret value to the installation client [col 24, lines 57-64].

15. As per claim 31, the combination of Chou et al and Saito teaches the method as applied above. Furthermore, Chou et al teaches determining if the installation of the copy of the software to be installed authorized (col 3 ln 59-col 4 ln3).

16. As per claims 32-33 the combination of Chou et al and Saito teaches the method as applied above. Furthermore, Saito teaches limiting repetitions of copying or transferring of data [col. 6 lines 9-12].

17. As per claim 36, the combination of Chou et al and Saito teaches the method as applied above. Furthermore, Saito teaches generating software encryption key based on customer information IC (col. 23, lines 50-55).

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO Form 892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beemnet W Dada whose telephone number is (571) 272-3847. The examiner can normally be reached on Monday - Friday (9:00 am - 5:30 pm).

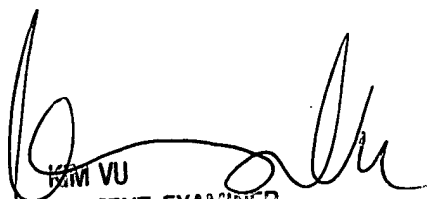
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Beemnet Dada

December 7, 2004


KIM VU
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